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IN THE
Supreme Court of the United States
OCTOBER TERM, 1965

No. [REDACTED]

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HAZELTINE RESEARCH, INC. and ROBERT REGIS,
Petitioners,

v.

DAVID L. LADD, COMMISSIONER OF PATENTS,
Respondent.

On Certiorari to the United States Court of Appeals for the
District of Columbia Circuit

MOTION FOR LEAVE TO FILE BRIEF AS AMICUS CURIAE
AND BRIEF IN SUPPORT OF PETITIONER

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**MOTION FOR LEAVE TO FILE BRIEF AS AMICUS CURIAE
IN SUPPORT OF PETITIONER**

Irwin M. Aisenberg, pursuant to rule 42 of the Revised Rules of the Supreme Court of the United States, respectfully moves for leave to file, in the above-entitled case, his brief amicus curiae, annexed hereto, which supports the position of Hazeltine Research, Inc. and Robert Regis, petitioners herein. Pursuant

to Rule 42, the consent to file brief *amicus curiae* was requested of the parties, but was denied.

The interest of *amicus* is purely academic, although it was initiated a number of years ago in connection with actual cases in private practice. Said cases have since been terminated, and *amicus* is now a corporate patent counsel with no cases involving the subject issue.

Amicus has extensively researched the sole point of law in issue, including a review of every published court decision directed thereto since *Alexander Milburn v. Davis-Bournonville* (1926) 270 U.S. 390, and a review of the legislative history of Title 35 U.S. Code, Section 102 (66 Stat. 797) and Section 103 (66 Stat. 798). His analysis and reasoning are materially different than their counterparts in the Petitioners' brief.

Historically, the issue has most often been attacked from the standpoint of facts peculiar to individual cases without due consideration of the "overall picture". As a result the case law provides many conflicting views with no uniform rational analysis. To resolve existing conflicts, the particular facts of the case should be evaluated in the light of the entire law on the subject issue. Petitioners' brief is directed to the specific facts of their case; the *amicus* brief considers the pertinent case and statutory law from a broader viewpoint. The assimilation of the particular facts within the framework of the broader viewpoint will provide guidelines which others can understand and follow and will resolve the conflicts engendered by the unduly limited viewpoint of prior lower court decisions.

Moreover, the analysis and reasoning of *amicus* are based in part on analogies beyond those considered in said Petitioners' brief. In the legislative history of

the current statutory provisions in issue, for example, one of the proposed bills illustrated the intent to exclude copending patents from a precursor to Title 35 United States Code, Section 103. The fact that a copending patent of a patentee (or applicant for U.S. Letters Patent) cannot be employed as prior art is also significant in the consideration of the sole question before the Court. These points and others not covered by the Petitioners' brief are presented in the appended brief. Since they lead to conclusions contrary to the position of the Commissioner of Patents, it is considered unlikely that they will be offered in the brief of the Solicitor General.

The amicus brief provides the perspective for the evaluation of the point of law before the Court; it is directed to the background and very foundation from which the ultimate decision will conclude.

For the reasons stated, amicus respectfully requests leave to file the attached brief in support of the Petitioners.

Respectfully submitted,

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BRIEF AMICUS CURIAE

INTRODUCTORY STATEMENT

Such portions of the brief of Hazeltine Research, Inc. and Robert Regis, petitioners herein, setting forth the Opinions Below, the Jurisdiction, the Statutes Involved, the Question Presented and the Statement of the Case are adopted.

The interest of the amicus in this cause is fully set forth in the motion preceding this brief.

SUMMARY OF ARGUMENT

A patent issued subsequent to the filing date of an application for United States Letters Patent is *not* "prior art" with respect to the application within the meaning of Title 35 U.S. Code, Section 103 (66 Stat. 798).

ARGUMENT

THE STATUS OF COPENDING PATENTS FOR PRECLUDING PATENTABILITY

One of the most difficult concepts of patent law is the status of subject matter described, but not claimed, in a patent. It is clear from the landmark decision in *Alexander Milburn v. Davis-Bournonville* (1926) 270 U.S. 390, that the validity of a patent can be negated by subject matter constructively reduced to practice in a copending patent, i.e. a patent filed prior to but issued subsequent to the filing date of the subject patent. The theory upon which patentability is precluded is that the patentee is not the *first inventor* [Title 35 U.S. Code, Section 102(e) (66 Stat. 797)] of the claimed invention because said invention was previously constructively reduced to practice by another prior to the patentee's earliest provable date.

Constructive Reduction to Practice

Constructive reduction to practice is accorded the same status as an actual reduction to practice for the purpose of negating first inventorship. Of the essence is that any subject matter relied upon in a copending patent must be constructively reduced to practice therein. Not all subject matter disclosed in a patent satisfies the requirements.

A description of an invention in a formal application for United States Letters Patent, which description is sufficient to support an allowable claim to the invention, renders the application a constructive reduction to practice (See "Walker on Patents", Deller's Edition, Baker Voorhis and Co., 1937, Vol. II, Sec. 204) of said invention, effective as of the filing date of said application. A copending continuing United States application containing a description of the said invention sufficient to support an allowable claim thereto is also a constructive reduction to practice, of said invention; the effective date of the constructive reduction to practice, however, is the filing date of the parent copending application, even though the parent application may have been either abandoned or patented *subsequent* to the filing date of the continuing application.

A constructive reduction to practice in the United States exists only a) while the application containing same or a continuation thereof is pending in the United States Patent Office, and/or b) after either has issued as a United States Patent. [But, see *James B. Clow and Sons, Inc. v. U. S. Pipe and Foundry Co.* (C.A. 5, 1963) 313 F. 2d 46, (C.A. 5, 1965) 146 USPQ 320, and *United Chromium, Inc. v. General Motors Corporation et al.* (C.A. 2, 1936) 85 F. 2d 577.] The effective date of a constructive reduction to practice of a claimed invention may be prior to the actual filing date in the United States if the requirements of Title 35 U.S. Code, Section 119 (66 Stat. 800) are satisfied.

The test for sufficiency of compliance of an application with Title 35 U.S. Code, Section 112 (66 Stat. 798) to constitute a constructive reduction to practice is what the application as a whole communicates to one skilled in the art. The application need not expressly

set forth matters commonly understood by person skilled in the art [*Carnegie Steel Co., Ltd. v. Cambria Iron Co.*, (1902) 185 U.S. 403; *In re Johnson* (1960) 48 CCPA 733, 282 F. 2d 370; *Lafon v. Zirm and Pongratz* (PO Bd. Pat. Inter, 1962) 141 USPQ 442; *Stauffer Chemical Co. et al. v. Watson* (D.D.C., 1954) 119 F. Supp. 312; *The Webster Loom Co. v. Higgins et al.* (1882) 105 U.S. 580].

Identity of Invention vs. Patentability Over

There are two further concepts of patent law which are inextricably "tangled" with and are much less developed than the issue at hand. What has been for years a "catch-all" phrase: "unpatentable over", includes both. [See *In re Sebek and Spero* (1965) 52 CCPA, 44, 46.] 146 USPQ 44, 46.]

The same invention can be expressed by a plurality of people in different terms and even with different limitations. [See *In re Siu* (1955) 42 CCPA (Patents) 864, 222 F. 2d 267.] No matter how an invention is claimed, one is not entitled to a patent therefor if the *same* invention was constructively reduced to practice earlier by another because the claimant is not the first inventor of said invention. This is a concept of identity of invention upon which 35 U.S.C. 102(e) and the Milburn decision are based. In fact the entire Section (Title 35 U.S. Code, Section 102) is directed to the identity of the invention.

The other concept concerns a plurality of inventions, one of which is "not patentable over" the other(s). All new and distinct inventions are not patentable. The test for patentability for new and distinct inventions is provided by 35 U.S.C. 103. It is thus seen

that Section 103, directed to distinct inventions, is conceptually incompatible with Section 102, directed to the same invention.

First Inventorship

The issue of first inventorship is the sole subject matter with which 35 U.S.C. 102(e) is concerned. Disclosures of other inventions in copending patents cannot negate first inventorship, and disclosures which are not constructively reduced to practice in copending patents cannot negate first inventorship because they do not constitute evidence that another was a prior inventor of the same invention. A disclosure of a mere concept does not constitute prior inventorship.

Prior Art

When a term of art is employed by many who are unskilled in the art and without assistance from the art-skilled, only confusion can develop. When the term has a generic as well as a specific meaning and is employed in the statute without definition in spite of the fact that it is variously defined in the very case law which is allegedly codified, the inevitable chaos can only be awaited.

Where the term was apparently employed for convenience in *Detrola v. Hazeltine* (1941) 313 U.S. 259, no record arguments could be found either in support or in derogation of the meaning accorded said term by this Honorable Court. There is no reason to suspect that the particular usage, which was not critical to the issues presented in the *Detrola* Case, was any more in the legislative intent which went into the

formulation and enactment of 35 U.S.C. 103 than the later usage by the Honorable Learned Hand [*Old Town Ribbon and Carbon Co., Inc. v. Columbia Ribbon and Carbon Mfg. Co., Inc. et al.* (C.A. 2, 1947) 159 F. 2d 379; *Conmar Products Corp. v. Universal Slide Fastener Co., Inc. et al.* (C.A. 2, 1949) 172 F. 2d 150]. The Honorable Judge Hand, in his latest decisions concerned with the point in question, made it unequivocally clear that copending patents are not prior art.

The CCPA has maintained that a patent issued on an applicant's copending application is not "prior art" [*In re Heinle* (CCPA, 1965) 145 USPQ 131.] This conclusion is difficult to understand if the Statute equates a patent (as of its filing date) with a publication of the same date. If an applicant publishes, he must file his application within one year after the date of publication to avoid a statutory bar; Heinle waited seven years before filing his continuation-in-part. It is submitted that a copending patent either is or is not "prior art", irrespective of who is the applicant thereof. The legal fiction with respect to copending patents arises because an applicant's own copending patent cannot negate first inventorship in the applicant. Since this is the only statutory justification for the use of a copending patent, fictions had to be devised when copending patents (of others) were employed other than to negate first inventorship. The "first inventorship" construction of Section 102(e) is wholly consistent with the established practice concerning an applicant's own copending patent. The exclusion of copending patents from "prior art" under Section 103 and the limitation thereof to the issues of first

inventorship are supported by the construction of the statute as a whole and avoids many of the fictions and complexities which are otherwise necessitated.

The Development of the 1952 Act

On January 10, 1950, Representative Joseph R. Bryson (M.C., Chairman, Subcommittee No. 4) presented a preliminary draft (Rep. Joseph R. Bryson, "Proposed Revision and Amendment of the PATENT LAWS," Preliminary Draft with Notes, Committee Print, U.S. Government Printing Office, Washington, D. C.) of a proposed bill for a general revision and codification of the patent laws. Section 22,¹ Section 23,²

¹ Conditions for patentability. Novelty and loss of right to patent

An invention shall not be considered new or capable of being patented if

(a) the invention was known or used by others in this country, or patented or described in any printed publication in this or any foreign country, before the invention thereof by the applicant for patent, or if

(b) the invention was patented or described in any printed publication in this or any foreign country or in public use or on public sale in this country, more than one year prior to the date of the application for patent in the United States, or if

(c) the invention is proved to have been abandoned, or if

(d) the invention was first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country.

² Conditions for patentability, lack of invention

A patent may not be obtained though the invention is not identically disclosed or described in the material specified in section 22 of this title, if the differences between the subject matter sought to be patented and said material are such that the subject matter as a whole would be obvious to an ordinary person skilled in the art.

and Section 24³ are of particular interest to the discussion at hand. The reference of Section 23 (a predecessor of 35 U.S.C. 103) to section 22 clearly did not include copending patents, which were separately provided for in Section 24. The distinct treatment is evidence that copending patents were not considered available with respect to the issue of presence or absence of "patentable invention". Section 103 of H.R. 9133⁴ corresponds in general to section 23 of the preliminary draft.

The general part of the Committee Report (P. J. Federico, "Commentary on the New Patent Act", 35

³ Undisclosed prior knowledge or use

Whenever it appears that an applicant for patent, at the time of making his application, believed himself to be the original and first inventor of the thing patented, the same shall not be refused, or if granted, held to be void, solely on account of the invention having been known or used by some other person, before his invention thereof (without having been patented or described in a printed publication or in public use or on sale, as specified in section 22 a and b of this title), unless

(a) it was disclosed or used in the United States by such other person in such manner that it had become available to the public, or described in a printed publication, before the date of the application for patent, or

(b) it was described in a patent granted on an application filed in the United States before the invention thereof by the aforementioned applicant, or

(c) it was patented in the United States.

⁴ Conditions for patentability, nonobvious subject matter

A patent may not be obtained though the invention is not identically disclosed or described in the material specified in section 102 of this title, if the differences between the subject matter sought to be patented and said material are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art.

U.S.C.A., Sec. 1-110, pp. 20 and 21) states with reference to section 103:

"... An invention which has been made, and is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was *known* before is not considered sufficiently great to warrant a patent. . . . Section 103 . . . refers to the difference between the subject matter sought to be patented and the prior art, meaning what was *known* before as described in Section 102. . . ." (Emphasis added.)

Mr. Federico continues to explain:

"... The newness, that is the difference over what was previously known, must be sufficient in character, or in quantity, or in quality, in order that the new thing may be patented. This requirement has commonly been referred to as the requirement for the presence of invention; when the requirement is not present, it is stated that the subject matter involved lacks inventions. The comparison is between the subject matter claimed to be patentable and what is disclosed or described in the *available* statutory prior art material, and it is irrelevant whether the claimant knew or did not know this prior art material. The inventor may indeed have made an invention in the psychological sense, but it would nevertheless not be patentable if the quantum of novelty over the prior art material of which he may have been in total ignorance was not sufficient. This requirement for invention with which we are here concerned is more of a legal concept than a psychological one. . . ." (Emphasis added.)

In *Stanley Works v. Rockwell Mfg. Co.* (C.A. 3, 1953) 203 F. 2d 846, the Court states that Section 103, which provides in effect that an invention which has

been made, and which is new in the sense that it has not been made before, may still not be patentable if the difference between the new thing and what was *known* before is not considered sufficiently great to warrant a patent, is merely a codification of decisional patent law. [See also *Joseph Bancroft & Sons Co. v. Brewster Finishing Co.* (D.N.J., 1953) 113 F. Supp. 714.]

The interpretation of what was *known* before should be consistent with the definition of "known" arrived at by the CCPA in *In re Schlittler et al.* (1956) 43 CCPA 986, 234 F. 2d 882. [This was modified on May 27, 1965, by the CCPA in *In re Borst*, 145 USPQ 554. (See also *In re Taub, Wendler and States* (CCPA, 1965) 146 USPQ 384.)] It must be further appreciated that the issue of first inventorship is entirely different from that of patentability over references. The two should not be either confused or combined. 35 U.S.C. 103 applies only to the latter.

Combining Disclosures of Copending Patents

Whether disclosures of copending patents can be combined with other such disclosures or with disclosures from prior art cannot be considered in a vacuum. It is this fact, perhaps more than any other, which has contributed most to the difficulties of those who insist upon convenient generalities. For any disclosure in a copending patent to be available as of the patent's effective U. S. filing date, it must be constructively reduced to practice in the copending patent and it must, in the proposed combination, preclude first inventorship in subject matter defined by the claims of another.

There is a ground for rejecting claims of an applicant for U.S. Letters Patent which provides a good basis for understanding the issue at hand. This re-

jection is founded on the fact that the claims define only an old or exhausted combination. The Examiner usually follows such a rejection by an indication of novelty in a particular subcombination which should be claimed specifically if it constitutes the applicant's invention.

If, for example, an applicant claims an automobile with a specific novel carburetor capable of delivering 75 miles per gallon of regular gasoline, the Examiner can reject the claimed automobile as an old combination and suggest that the applicant direct his claims to the novel carburetor, if such is his invention. If the carburetor per se also lacks novelty, the applicant is not the first inventor of the claimed invention; he is neither the first inventor of the combination, i.e. the automobile, nor the first inventor of the subcombination, i.e. the carburetor. His first inventorship would be precluded whether said combination and/or said subcombination were constructively reduced to practice in one or a plurality of copending patents as long as any residue is either known or described in available publications.

It is this use of a copending patent, either by itself, in combination with another copending patent, or in combination with a publication which can preclude patentability. The preclusion is based solely on negating first inventorship. There is no real authority for using a copending patent for any other purpose.

Conclusion

Based on a review of every published decision since the Milburn Case and concerned with the status of copending patents for precluding patentability and in-

validating issued patents and based on a study of the briefs and records before the courts in presumably landmark cases which led to some of said decisions, copending patents are available to preclude patentability to a subsequent inventor of subject matter constructively reduced to practice therein. Copending patent disclosures cannot be combined with other disclosures except for the very limited purpose of precluding first inventorship of the invention claimed by another.

Copending patents are not "prior art" within the meaning of that expression in 35 U.S.C. 103. Section 103 defines the quantum of novelty of a new and distinct invention to warrant patentability thereof. First inventorship in a new and distinct invention cannot be negated by a copending patent which discloses only other inventions, no matter how closely related such other inventions may be. No logically consistent rationale to the contrary is found in any of the reviewed case law. The Statute, which is merely a codification of the case law, certainly does not alter these conclusions.

The instant rationale and preceding interpretation of the totality of case law and statute is wholly consistent with the virtually uncontroverted position that copending patents of the same inventor are *not* "prior art", with *reasoned* decisions and developments throughout the years since Milburn, with the latest holdings on the subject by the Honorable Learned Hand, the Circuit Court of Appeals judge who had by far the greatest understanding, appreciation and experience with respect to the issue, with the words of the Statute and the development thereof, and with the in-

tent clearly expressed by the Honorable United States Supreme Court in its *Detrola* decision.

For the foregoing reasons, *amicus curiae* submits that the judgment for the Court of Appeals should be reversed.

Respectfully submitted,

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September 1965